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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,217	ROGAN ET AL.	
	Examiner	Art Unit	
	LENNIN R. RODRIGUEZ	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-59* is/are pending in the application.

4a) Of the above claim(s) *43 and 52* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-42,44-51 and 53-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A in the reply filed on 5/14/2009 is acknowledged.

2. Claims 43 and 52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/14/2009.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/2009 has been entered.

Response to Arguments

4. Applicant's arguments, see pages 8 and 9, filed on 5/14/2009, with respect to the rejection(s) of claim(s) 35, 47 and 58 under 35 U.S.C. 103(A) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Tokashiki (US 7,352,487).

5. Claim objections have been withdrawn in view of the submitted amendment.

Claim Objections

6. Claims 45 and 45 objected to because of the following informalities:

(1) There are 2 claims numbered 45, for the effects of this rejection the second claim 45 is going to be treated as claim 60 to avoid any confusion in the rejection.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 35-42, 44-51 and 53-59 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the

[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, in claim 1, receiving a digital image..., selecting a portion of the image..., determining an overlapping portion... and displaying the overlapping portion... do not have to be performed necessarily by a machine and can reasonably be performed by a mental or manual method of a user. Claims 47 and 58 recite similar features therefore the same analogy applies.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 35-42, 44 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokashiki (US 7,352,487) in view of well know prior art.

(1) regarding claims 35:

Tokashiki '487 discloses a method for displaying a digital image, comprising:

receiving a digital image from a user (column 3, lines 50-57, where a user creates or modifies an image and is received by the MFPs via a network);

a first image portion having a first aspect ratio (column 12, lines 54-57, where the area 1401 in Fig. 15, is evident that it has a first ratio);

a second image portion having a second aspect ratio, wherein the second aspect ratio is different from the first aspect ratio (column 12, lines 54-57, where the area 1402 in Fig. 15, is evident that it has a second ration different form the first ratio);

determining an overlapping portion between the first image portion and the second image portion (column 12, lines 58-62, where the area 1403 represents the common overlapping area of the previous areas 1401 and 1402); and

displaying the overlapping image portion without displaying portions of the digital image outside of the overlapping portion such that only the overlapping portion of the digital image is visible to the user (as can be seen in Fig. 15 the area 1403 is only shown without showing any of the non-overlapping portions of the other two areas, it is evident in column 9, lines 49-54, that this area can be displayed to the display 210 for confirmation in a preview).

Tokashiki '487 discloses all the subject matter as described above except selecting, in the digital image, a first image portion and a second image portion.

However the examiner is taking official notice that it is well-known in the art to select, in the digital image, a first image portion and a second image portion.

Having a system of Tokashiki '487 reference and then given the well known prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 to include selecting, in the digital image, a first image portion and a second image portion as it would have been obvious because to be able to select a first portion of an image and a second portion of the image with a different ratio to give users options to modify the layout of an image, therefore making it user friendlier and convenience for the user as well.

(2) regarding claim 58:

Tokashiki '487 further discloses a method for displaying a digital image, comprising:

receiving, from a user, a digital image having an image width and an image height (column 3, lines 50-57, where a user creates or modifies an image and is received by the MFPs via a network, all images have a width and height in the paper);

a first image portion having a first aspect ratio (column 12, lines 54-57, where the area 1401 in Fig. 15, is evident that it has a first ratio);

a second image portion having a second aspect ratio, wherein the second aspect ratio is different from the first aspect ratio (column 12, lines 54-57, where the area 1402 in Fig. 15, is evident that it has a second ration different form the first ratio);

determining an overlapping portion between the first image portion and the second image portion (column 12, lines 58-62, where the area 1403 represents the common overlapping area of the previous areas 1401 and 1402), wherein the step of determining an overlapping portion further comprises defining a default position for the overlapping portion in the digital image (the area 1403 in Fig. 15 is a default definition for the overlapping area), wherein the first image portion and the second image portion are selected to maximize the area of the overlapping portion (column 12, lines 62-67, where the overlapping area is selected such as areas 1401 and 1402 can be maximized with no missing parts); and

displaying the overlapping image portion without displaying portions of the digital image outside of the overlapping portion such that only the overlapping portion of the digital image is visible to the user (as can be seen in Fig. 15 the area 1403 is only

shown without showing any of the non-overlapping portions of the other two areas, it is evident in column 9, lines 49-54, that this area can be displayed to the display 210 for confirmation in a preview).

Tokashiki '487 discloses all the subject matter as described above except selecting, in the digital image, a first image portion and a second image portion.

However the examiner is taking official notice that it is well-known in the art to select, in the digital image, a first image portion and a second image portion.

Having a system of Tokashiki '487 reference and then given the well known prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 to include selecting, in the digital image, a first image portion and a second image portion as it would have been obvious because to be able to select a first portion of an image and a second portion of the image with a different ratio to give users options to modify the layout of an image, therefore making it user friendlier and convenience for the user as well.

(3) regarding claim 36:

Tokashiki '487 further discloses wherein the first image portion has a first height and has a first width (column 3, lines 50-57, all images have a width and height in the paper), wherein the second image portion has a second width larger than the first width (as can be appreciated in Fig. 15, 1402 (second image) has a larger width), wherein the second image portion has a second height smaller than the first height (as can be appreciated in Fig. 15, 1402 (second image) has a smaller height).

(4) regarding claim 37:

Tokashiki '487 further discloses wherein the digital image has an image width and an image height (column 3, lines 50-57, all images have a width and height in the paper), wherein the first image portion has a first height substantially the same as the image height and has a first width smaller than the image width (as can be appreciated in Fig. 15, 1401 (first image portion) has a height substantially the same as the paper size (taken the paper as the image as a whole) and a smaller width), wherein the second image portion has a second width substantially the same as the image width and has a second height smaller than the image height (as can be appreciated in Fig. 15, 1402 (second image portion) has a width substantially the same as the paper size (taken the paper as the image as a whole) and a smaller height).

(5) regarding claim 38:

Tokashiki '487 further discloses wherein the first aspect ratio and the second aspect ratio are determined by different print formats (column 12, lines 54-67, where the two ratios are determined by two different MFP having different formats: monochromatic and color).

(6) regarding claim 39:

Tokashiki '487 further discloses wherein the first image portion and the second image portion are selected to maximize the area of the overlapping portion (column 12, lines 62-67, where the overlapping area is selected such as areas 1401 and 1402 can be maximized with no missing parts).

(7) regarding claim 40:

Tokashiki '487 discloses all the subject matter as described above except selecting a position for the overlapping portion in the digital image by changing a position of the first image portion, or a position of the second image portion, or a combination thereof.

However the examiner is taking official notice that having a system of Tokashiki '487 reference and then given the well known prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 to include selecting, in the digital image, a first image portion and a second image portion as it would have been obvious because to be able to select a first portion of an image and a second portion of the image with a different ratio and then have the area common to those two as a way of standardization of the printing process to give users options to modify the layout of an image, therefore making it user friendlier and convenience for the user as well.

(8) regarding claim 41:

Tokashiki '487 further discloses wherein the step of determining an overlapping portion further comprises defining a default position for the overlapping portion in the digital image (the area 1403 in Fig. 15 is a default definition for the overlapping area).

(9) regarding claims 42 and 59:

Tokashiki '487 further discloses wherein the default position is selected from a group consisting of a bottom position in the digital image, a center position in the digital image (column 12, lines 58-62, where the area 1403 represents the common overlapping area of the previous areas 1401 and 1402 and as it is shown in the figure it

is at the center of the paper (taken as the whole image)), and a top position in the digital image.

(10) regarding claim 44:

Tokashiki '487 further discloses producing an image print based on the overlapping portion of the digital image (column 13, lines 1-12, where the common area is the one being printed).

11. Claims 46-51 and 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokashiki (US 7,352,487) and well know prior art as applied to claims above, and further in view of Rosenbaum et al. (US 6,256,109).

(1) regarding claim 47:

Tokashiki '487 discloses a method for displaying a digital image, comprising:

receiving a digital image from a user (column 3, lines 50-57, where a user creates or modifies an image and is received by the MFPs via a network);

a first image portion having a first aspect ratio (column 12, lines 54-57, where the area 1401 in Fig. 15, is evident that it has a first ratio);

a second image portion having a second aspect ratio, wherein the second aspect ratio is different from the first aspect ratio (column 12, lines 54-57, where the area 1402 in Fig. 15, is evident that it has a second ration different form the first ratio);

determining an overlapping portion between the first image portion and the second image portion (column 12, lines 58-62, where the area 1403 represents the common overlapping area of the previous areas 1401 and 1402); and

displaying the overlapping image portion without displaying portions of the digital image outside of the overlapping portion such that only the overlapping portion of the digital image is visible to the user (as can be seen in Fig. 15 the area 1403 is only shown without showing any of the non-overlapping portions of the other two areas, it is evident in column 9, lines 49-54, that this area can be displayed to the display 210 for confirmation in a preview).

Tokashiki '487 discloses all the subject matter as described above except selecting, in the digital image, a first image portion and a second image portion.

However the examiner is taking official notice that it is well-known in the art to select, in the digital image, a first image portion and a second image portion.

Having a system of Tokashiki '487 reference and then given the well known prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 to include selecting, in the digital image, a first image portion and a second image portion as it would have been obvious because to be able to select a first portion of an image and a second portion of the image with a different ratio to give users options to modify the layout of an image, therefore making it user friendlier and convenience for the user as well.

Tokashiki '487 and well known prior art disclose all the subject matter as describe above except wherein the first and second aspect ratio are selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11.

However, Rosenbaum '109 teaches wherein the first and second aspect ratio are selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11 (column 2, lines 12-

16, where the user has the capability of selecting what aspect ratio they want for the image, even though there is no specific ratio mentioned, it would be obvious to try any of the group of rations mentioned in the claim as every user has its own preferences of how the image should look like).

Having a system of Tokashiki '487 and well known prior art and then given the well-established teaching of Rosenbaum '109 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 and well known prior art to include wherein the first and second aspect ratio are selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11 as taught by Rosenbaum '109 because it would be obvious to try any of the group of rations mentioned in the claim as every user has its own preferences of how the image should look like.

(2) regarding claim 46:

Tokashiki '487 and well known prior art disclose all the subject matter as describe above except wherein the first aspect ratio is selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11.

However, Rosenbaum '109 teaches wherein the first aspect ratio is selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11 (column 2, lines 12-16, where the user has the capability of selecting what aspect ratio they want for the image, even though there is no specific ratio mentioned, it would be obvious to try any of the group of rations mentioned in the claim as every user has its own preferences of how the image should look like).

Having a system of Tokashiki '487 and well known prior art and then given the well-established teaching of Rosenbaum '109 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 and well known prior art to include wherein the first aspect ratio is selected from the group consisting of 10:7, 6:4, 7:5, 5:4, and 14:11 as taught by Rosenbaum '109 because it would be obvious to try any of the group of rations mentioned in the claim as every user has its own preferences of how the image should look like.

(3) regarding claim 53:

Tokashiki '487 further discloses wherein the first image portion has a first height and has a first width (column 3, lines 50-57, all images have a width and height in the paper), wherein the second image portion has a second width larger than the first width (as can be appreciated in Fig. 15, 1402 (second image) has a larger width), wherein the second image portion has a second height smaller than the first height (as can be appreciated in Fig. 15, 1402 (second image) has a smaller height).

(4) regarding claim 54:

Tokashiki '487 further discloses wherein the digital image has an image width and an image height (column 3, lines 50-57, all images have a width and height in the paper), wherein the first image portion has a first height substantially the same as the image height and has a first width smaller than the image width (as can be appreciated in Fig. 15, 1401 (first image portion) has a height substantially the same as the paper size (taken the paper as the image as a whole) and a smaller width), wherein the

second image portion has a second width substantially the same as the image width and has a second height smaller than the image height (as can be appreciated in Fig. 15, 1402 (second image portion) has a width substantially the same as the paper size (taken the paper as the image as a whole) and a smaller height).

(5) regarding claim 48:

Tokashiki '487 further discloses wherein the first image portion and the second image portion are selected to maximize the area of the overlapping portion (column 12, lines 62-67, where the overlapping area is selected such as areas 1401 and 1402 can be maximized with no missing parts).

(7) regarding claim 49:

Tokashiki '487 discloses all the subject matter as described above except selecting a position for the overlapping portion in the digital image by changing a position of the first image portion, or a position of the second image portion, or a combination thereof.

However the examiner is taking official notice that it is well-known in the art to select, in the digital image, a first image portion and a second image portion.

Having a system of Tokashiki '487 reference and then given the well known prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tokashiki '487 to include selecting, in the digital image, a first image portion and a second image portion as it would have been obvious because to be able to select a first portion of an image and a second portion of the image with a different ratio and then have the area common to those two as a way

of standardization of the printing process to give users options to modify the layout of an image, therefore making it user friendlier and convenience for the user as well.

(8) regarding claim 50:

Tokashiki '487 further discloses wherein the step of determining an overlapping portion further comprises defining a default position for the overlapping portion in the digital image (the area 1403 in Fig. 15 is a default definition for the overlapping area).

(9) regarding claim 51:

Tokashiki '487 further discloses wherein the default position is selected from a group consisting of a bottom position in the digital image, a center position in the digital image (column 12, lines 58-62, where the area 1403 represents the common overlapping area of the previous areas 1401 and 1402 and as it is shown in the figure it is at the center of the paper (taken as the whole image)), and a top position in the digital image.

(10) regarding claim 55:

Tokashiki '487 further discloses producing an image print based on the overlapping portion of the digital image (column 13, lines 1-12, where the common area is the one being printed).

12. Claims 45 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokashiki (US 7,352,487) and well know prior art as applied to claims above, and further in view of Leone et al. (US 5,596,346).

(1) regarding claim 45:

Tokashiki '487 and well known prior art disclose all the subject matter as describe above except displaying an image border surrounding the overlapping image portion.

However, Leone '346 teaches displaying an image border surrounding the overlapping image portion. (column 1, lines 60-62).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made displaying an image border surrounding the overlapping image portion as taught by Leone '346, in the system of Tokashiki '487 and well known prior art. The convenience of this added feature is that after the user sees and selects the preview options on an image he/she wants to have a finished product such as an impression thus giving the user freedom to do printouts of images previously displayed as a preview.

(2) regarding claims 60:

Tokashiki '487 and well known prior art disclose all the subject matter as described above except selecting an image border to be displayed surrounding the overlapping image portion.

However, Leone '346 teaches selecting an image border to be displayed surrounding the overlapping image portion (column 1, lines 62-66).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made selecting an image border to be displayed surrounding the overlapping image portion as taught by Leone '346, in the system of Tokashiki '487 and well known prior art. The convenience of this added feature is that after the user sees

and selects the preview options on an image he/she wants to have a finished product such as an impression thus giving the user freedom to do printouts of images previously displayed as a preview.

13. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokashiki (US 7,352,487), well know prior art and Rosenbaum et al. (US 6,256,109) as applied to claims above, and further in view of Leone et al. (US 5,596,346).

(1) regarding claim 56:

Tokashiki '487, well known prior art and Rosenbaum '109 disclose all the subject matter as describe above except displaying an image border surrounding the overlapping image portion.

However, Leone '346 teaches displaying an image border surrounding the overlapping image portion. (column 1, lines 60-62).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made displaying an image border surrounding the overlapping image portion as taught by Leone '346, in the system of Tokashiki '487 and well known prior art. The convenience of this added feature is that after the user sees and selects the preview options on an image he/she wants to have a finished product such as an impression thus giving the user freedom to do printouts of images previously displayed as a preview.

(2) regarding claims 57:

Tokashiki '487 and well known prior art disclose all the subject matter as described above except selecting an image border to be displayed surrounding the overlapping image portion.

However, Leone '346 teaches selecting an image border to be displayed surrounding the overlapping image portion (column 1, lines 62-66).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made selecting an image border to be displayed surrounding the overlapping image portion as taught by Leone '346, in the system of Tokashiki '487 and well known prior art. The convenience of this added feature is that after the user sees and selects the preview options on an image he/she wants to have a finished product such as an impression thus giving the user freedom to do printouts of images previously displayed as a preview.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Lennin R Rodriguez/
Examiner, Art Unit 2625